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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|------------------|
| 09/898,707  | 07/03/2001  | Thomas Zickell       | NEI-010XX                       | 2439             |
| 7590<br>Bourque & Associates, P.A.<br>Suite 303<br>835 Hanover Street<br>Manchester, NH 03104 |             |                      | EXAMINER<br>AUGHENBAUGH, WALTER |                  |
|   |             |                      | ART UNIT<br>1772                | PAPER NUMBER     |
| SHORTENED STATUTORY PERIOD OF RESPONSE  |             |                      | MAIL DATE                       | DELIVERY MODE    |
| 3 MONTHS  |             |                      | 02/05/2007                      | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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|------------------------------|--|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/898,707     | <b>Applicant(s)</b><br>ZICKELL, THOMAS |  |
|                              | <b>Examiner</b><br>Walter B. Aughenbaugh | <b>Art Unit</b><br>1772                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgement of Applicant's Amendments***

1. Applicant's amendments in claim 32 in the Amendment filed November 22, 2006 (Amdt. H) have been received and considered by Examiner.

### ***NEW REJECTIONS***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

3. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "said upper and said lower surfaces within said substrate" (lines 17-18) renders the claim indefinite: claim 32 recites the limitation "said upper and said lower surfaces within said substrate" in lines 17-18; there is insufficient antecedent basis for this limitation in the claim. The claim language prior to the limitation "said upper and said lower surfaces within said substrate" does not require the upper and lower surfaces to be "within said substrate".

Furthermore, the recitation that the upper and lower surfaces are "substantially free of said first asphalt composition" contradicts the language of claim 32 at lines 3-4 of the claim which requires that the substrate is "saturated with a first asphalt composition": the upper and lower surfaces are upper and lower surfaces of the substrate (lines 5-6), so the upper and lower surfaces of the substrate cannot be "substantially free of said first asphalt composition" if the substrate is "saturated with [the] first asphalt composition".

Furthermore, the recitation that the upper and lower surfaces are “substantially free of... said adhesive composition” contradicts the language of claim 32 at lines 14-15 of the claim which requires that the “second layer of an adhesive composition contact[s] said lower surface”: the lower surface of the substrate (lines 5-6) cannot be “substantially free of... said adhesive composition” if the “second layer of an adhesive composition contact[s] said lower surface [of the substrate]”.

### ***REPEATED REJECTIONS***

#### ***Claim Rejections - 35 USC § 112***

4. The 35 U.S.C. 112 rejection of claims 21 and 32 made of record in paragraph 5 of the previous Office Action mailed June 22, 2006 has been repeated for the reasons previously made of record, although the basis for rejection of claim 32 regarding the recitations “said upper surface of said first region” and “said lower surface of said first region” has been withdrawn due to Applicant’s amendments in claim 32 in Amdt. H (only the basis for rejection of claim 32 regarding the recitation “a second region disposed” is repeated: last sentence of paragraph 5 of the previous Office Action mailed June 22, 2006).

#### ***Claim Rejections - 35 USC § 102***

5. The 35 U.S.C. 102 rejection of claims 21, 22, 24, 29, 32-34, 36, 41 and 44 made of record in paragraph 6 of the previous Office Action mailed June 22, 2006 has been repeated for the reasons previously made of record, and for the following reasons that address the amendments made in claim 32 in Amdt. H: the first layer (coating, item 24) of the second asphalt composition contacts the upper surface of the substrate (impregnated mat, item 92) within the first region, and the second layer (adhesive, item 94) of the adhesive composition contacts the

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lower surface of the substrate (impregnated mat, item 92) within the first region in the instance where the first region includes the first layer (coating, item 24), the substrate (impregnated mat, item 92) and the second layer (adhesive, item 94). Simpson et al. teach that the substrate includes a second region disposed along at least the top and bottom edge regions of the substrate (the region at the left edge of the substrate as shown in Fig. 11 where the right edge of each unit of underlayment, item 90, overlaps with and contacts the left edge of the next underlayment, item 90, as shown in Fig. 11) where the upper and lower surfaces of the substrate (Applicant necessarily considers the claimed “said upper and said lower surfaces within said substrate” to be equivalent to the “upper” and “lower surface[s]” of the substrate recited in line 6 due to Applicant’s recitation “said upper and said lower surfaces” in lines 17-18 [which necessarily refers to the “upper” and “lower surface[s]” of the substrate recited in line 6]) are substantially free of the first asphalt composition, the second asphalt composition and the adhesive composition since the upper surface of the substrate at the second region does not contact coating, item 24 and since the lower surface of the substrate at the second region does not contact an asphalt composition (Fig. 1 and 9-11).

### *Response to Arguments*

6. Applicant’s arguments presented on pages 11-12 of Amdt. H regarding the 35 U.S.C. 112 rejection of claim 21 have been fully considered but are not persuasive.

A layer would not “contact” the upper surface of a region that also is the upper surface of the layer because there is nothing for the layer to actually “contact”. Contact occurs between two objects: for example, A contacts B. In the language at issue, the first layer corresponds to A in the hypothetical “A contacts B”, but there is no B in the language at issue. The first region

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cannot correspond to B because the upper surface of the first region is the same as the upper surface of the first layer: the upper surface of the first layer is the upper surface of the region, so the first layer cannot contact something that is a component of the first layer.

Applicant's diagram on page 11 of Amdt. H does not correspond to the claimed invention, so its value in rebutting the rejection of record cannot be ascertained and has not been explained by Applicant. Among the inconsistencies between the diagram and the claimed invention is that the first region is not equated with the first layer in claim 21 as is done in the diagram. Regardless, the "first layer" in the diagram cannot contact the "first region" in the diagram because they are one in the same. Object A cannot contact object A. Applicant argues that the "1<sup>st</sup> composition" in the diagram contacts the upper surface of the "first layer/region", but the claim language does not single out any composition as contacting the upper surface of the first region (the "second asphalt composition" would be the claimed composition that could be read as contacting the upper surface of the first region, but the claim language has been reasonably read to recite that the first layer [which is "of a second asphalt composition"] contacts the upper surface of the first region): the Office Action makes it plainly clear that the Office interprets the claim as reciting that the first layer contacts the upper surface of the first region. Paragraph 6 of the previous Office Action mailed June 22, 2006. Applicant's discussion regarding the "1<sup>st</sup> composition" in the diagram does not address the position of the Office that "it cannot be ascertained how a layer that is a component of a region would contact the upper surface of that region, since the only thing that would contact that region would be something that is not a component of that region" because this statement does not involve any compositions. Paragraph 5 of the previous Office Action mailed June 22, 2006. Applicant has not provided any

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support for equating the first layer with the first region in the diagram on page 11 of Amdt. H. Applicant has not provided support for the particular structure shown in the diagram, nor for the assignment of names to the respective components shown in the diagram. It does not appear that the ovals labeled “1<sup>st</sup> composition” contact the upper surface in the diagram: if the structure of Applicant’s invention is limited to the structure shown in the diagram on page 11 of Amdt. H (disregarding Applicant’s incorrect labeling of the components), the embodiment where any composition is in contact with the upper surface of the first region does not fall within the scope of Applicant’s invention.

7. Applicant’s arguments presented on page 12 of Amdt. H regarding the 35 U.S.C. 112 rejection of claim 32 have been fully considered but are not persuasive.

Applicant states that claim 32 “correctly recites to said upper and said lower surface introduced as the first element of the first substrate”: this statement is correct regarding the amendments made in lines 13 and 15, but incorrect regarding the amendment made in line 18. The claim language prior to the limitation “said upper and said lower surfaces within said substrate” does not require the upper and lower surfaces to be “within said substrate”, so there is no upper surface that is “within said substrate” (to which is referred in “said upper and said lower surfaces within said substrate”) prior to line 17, and there is no lower surface that is “within said substrate” (to which is referred in “said upper and said lower surfaces within said substrate”) prior to line 17. See new 35 U.S.C. 112 rejection of claim 32 made of record above in this Office Action.

8. Applicant’s arguments presented on pages 12-14 of Amdt. H regarding the 35 U.S.C. 102 rejection of claims 21 and 44 have been fully considered but are not persuasive.

Applicant's reference to "... providing a region of an edge region of the substrate..." is not directed to the claim language, so any argument based on this reference does not address the rejection of record: there is no "providing" step in article claim 21, and no "edge region", and therefore, no "region of an edge region of the substrate" is recited in claim 21.

Applicant states that the "Office Action then references Fig. 9 element 92 as having an upper and a lower surface...", but this is plainly an incorrect reading of the Office Action: Applicant suggests in this statement that the substrate 92 in its entirety is identified in the Office Action as the claimed second region, but "the edge of substrate 92" is plainly identified as corresponding to the claimed second region, not the entirety of substrate 92. Lines 5-9 of page 4 of the previous Office Action mailed June 22, 2006. Applicant's interpretation of what is "asserted by the Office Action" is plainly different from what is explicitly stated in the Office Action, so Applicant's argument that "Simpson does not teach a combination of regions as asserted by the Office Action" is unsupported and incorrect. Simpson teaches the structural and compositional limitations that are actually recited in claim 21 for the reasons of record. Paragraph 6 of the previous Office Action mailed June 22, 2006.

Applicant's arguments presented on page 14 of Amdt. H regarding the 35 U.S.C. 102 rejection of claim 44 depend upon Applicant's arguments regarding the 35 U.S.C. 102 rejection of claim 21, which have been addressed above.

9. Applicant's arguments presented on page 14 of Amdt. H regarding the 35 U.S.C. 102 rejection of claim 44 depend upon Applicant's arguments regarding the 35 U.S.C. 102 rejection of claim 21, which have been addressed above.



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10. Applicant's arguments presented on page 14 of Amdt. H regarding the art rejections of claims 22-31 depend upon Applicant's arguments regarding the 35 U.S.C. 102 rejection of claim 21, which have been addressed above.

11. Applicant's arguments presented on pages 14-15 of Amdt. H regarding the 35 U.S.C. 102 rejection of claim 32 have been fully considered but are not persuasive.

Applicant's arguments here depend in part upon Applicant's arguments regarding the 35 U.S.C. 102 rejection of claim 21, which have been addressed above.

Applicant's statement in the first sentence on page 15 of Amdt. H does not address the rejection of record: Applicant suggests in this statement that the substrate 92 in its entirety is identified in the Office Action as the claimed second region, but "the edge of substrate 92" is plainly identified as corresponding to the claimed second region, not the entirety of substrate 92. Lines 5-9 of page 4 of the previous Office Action mailed June 22, 2006. Applicant's statement "even at the edges where the underlayment 90 overlaps", which indicates that the edges of substrate 92 are coated with adhesive layer 94, is unsupported. Clarification is required as to what Applicant considers to be the "edges" of substrate 92. If Applicant intends to refer to the portion of the bottom of the substrate 92 at the end of the rolled material shown in Fig. 9 (i.e. the portion of the bottom of the substrate 92 at the far right of Fig. 9) as an "edge of substrate 90" as the language of lines 2-4 of page 15 of Amdt. H suggests, Applicant has not addressed the basis for the rejection record. Lines 5-9 of page 4 of the previous Office Action mailed June 22, 2006.

12. Applicant's arguments presented on pages 15-16 of Amdt. H regarding the art rejections of claims 33-43 depend upon Applicant's arguments regarding the 35 U.S.C. 102 rejection of claims 21 and 32, which have been addressed above.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Walter B. Aughenbaugh  
01/29/07

WBA

  
NASSER AHMAD 2/1/07  
PRIMARY EXAMINER